

**REMARKS**

Upon entry of this amendment, claims 1-7 and 11-17 are all the claims pending in the application.. Claims 8-10 are canceled by this amendment. Claims 11-17 are added as new claims. No new matter has been added.

**I. Claim Rejections under 35 U.S.C. § 103(a)**

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Makino et al. (U.S. Patent No. 5,555,767). Applicant respectfully traverses this rejection on the following basis.

Claim 1 recites the feature of discharging sucked liquid from a same nozzle directly into liquid remaining in a container at a discharging position which is horizontally different from a sucking position where the liquid has been sucked to thereby stir the liquid. The Examiner recognizes that Makino does not disclose this feature of claim 1. Nonetheless, the Examiner asserts that it would have been obvious to provide such a feature based on the teachings of Makino. Applicant respectfully disagrees.

Makino discloses a method of mixing a small amount of a liquid sample 1 with a second liquid 2 . For this purpose, the liquid sample 1 may be introduced into a container by bringing a droplet of the liquid sample 1 into contact with the inclined inner wall of a container (see Fig. 4B). The second liquid 2 is then introduced onto the liquid sample 1 to mix and stir both liquids. The second liquid 2 is introduced into the container 24 by moving a pipette 12 containing the second liquid 2 toward the inner wall of the container 24 when the liquid sample 1 is placed on the inner wall of the container 24.

Makino also teaches that the resulting mixed liquid can be sucked and discharged for a uniform mixing (see col. 8, lines 34-40). The Examiner asserts that Makino fails to teach where the repeated suction and discharge steps take place. Applicant disagrees. As clearly shown in Figs. 2F-2G, the repeated suction and discharge steps take place with the pipette 12 immersed in the liquid and positioned in the same horizontal position (see Figs. 2F-2G and col. 8, lines 34-40).

Although Makino teaches a horizontal movement of a pipette to introduce a liquid from outside into a container as well as a repeated suction and discharge step by using the pipette, which is immersed in the liquid in the same horizontal position, Makino does not provide motivation to perform the repeated suction and discharge by horizontally moving the pipette. Nowhere in Makino is there a teaching or suggestion that the pipette containing a liquid, which is sucked from a container, is moved horizontally from a sucking position to another position where the liquid is discharged back into the container for a more efficient stirring.

In the Office Action, the Examiner points to col. 10, lines 54-55 of Makino and alleges that it would have been obvious to move the discharge position to an inclined position as depicted in Fig. 4D. Contrary to the allegation of the Examiner, however, Fig. 4D of Makino does not depict discharging liquid that is sucked from the container. Rather, Fig. 4D merely depicts discharging a second liquid 2 that originated from outside of the container. Indeed, there is absolutely no teaching or suggestion in Makino that the position shown in Fig. 4D would be desirable for discharging liquid sucked from the container.

In addition, Applicant submits herewith a Declaration Under 37 C.F.R. § 1.132 which includes data demonstrating the advantages of using the mixing method according to claim 1 of the present invention as compared to the mixing method as disclosed by Makino.

The results in the Declaration show that the method of making the present invention according to Conditions A and D is superior to the method of Makino according to Conditions C and F in which sucking and discharging are carried out while the top of the nozzle is sunk in the liquid. Makino discusses that the stirring effects by sucking and discharging at the same position in the same liquid are not clear (see col. 12, lines 19-40 and col. 13, lines 46-49). In the present invention, this point is clarified.

When the liquid is sucked from the container and discharged into the same container, it is apparent from the comparison of the results between Conditions A and B and the comparison of the results between Conditions C and D and that the horizontal movement of the nozzle according to the present invention provides stirring having excellent effects.

In the present invention, the same effects can be obtained in Condition D in which the sucked and discharged amount is small, similar to the effects in Condition A in which the sucked and discharged amount is large. On the other hand, in Conditions B, C, E and F, the effects are insufficient, even if the top of the nozzle is in the air when the liquid is discharged.

Accordingly, the comparative data set forth in the attached Declaration is evidence of the unexpected superiority of the invention not expected in view of the prior art. Based on the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 1. Claims 2-7 depend from claim 1 and therefore incorporate all of the

features thereof. Therefore, Applicant submits that these claims are patentable at least by virtue of their dependency.

## **II. New Claims**


Claims 11-17 are added as new claims. Applicant submits that these claims patentably distinguish over the cited prior art based on the combination of features recited therein.

## **III. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicants hereby petition for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,

  
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